

Appln. No. 10/593,138

Atty. Docket: MVS-1

REMARKS

The restriction requirement set forth in the Office action mailed 08/17/2011 is respectfully traversed. Pursuant to 37 CFR 1.143, applicants elect, with traverse the subject matter of claims 103-109 and 111.

For convenience, this RESPONSE uses the Office's action's designations Invention I and Invention II, even though all of the claims in the present application are, in fact, directed to one invention.

Office Action Applies the Wrong Criteria/Standards

The present application was filed under 35 USC 371 as a national stage filing of a PCT application. Thus restriction practice under 37 CFR 1.141 - 1.146 is not applicable to the present case. Rather what applies are only the "unity of invention" rules applicable to international applications. As noted in MPEP § 893.03(d):

Examiners are reminded that unity of invention (not restriction practice pursuant to 37 CFR 1.141 - 1.146) is applicable in international applications (both Chapter I and II) and in national stage applications submitted under 35 U.S.C. 371.

The Office action does, indeed, make reference to PCT Rule 13.1 and 37 CFR 1.499. However, in purporting to apply the provisions thereof, the Office action uses the wrong criteria. Specifically, the Office action invokes MPEP §806.05(d) in asserting that Invention I and Invention II are directed to distinct inventions because they are "related as subcombinations disclosed as usable together in a single combination" and that, moreover, they each have a "separate utility."

But those criteria apply only to applications filed under 35 USC 111.

Note the heading:

806.05(d) ... Restriction in Applications Filed Under 35 U.S.C. 111...

The proper criteria to be applied to a national stage PCT application filed under 35 USC 371 are set forth in 37 CFR 1.475, entitled "Unity of invention ... during the national stage" as further discussed in MPEP §1893.03(d)

Indeed, applicants' two families of claims meet the unity of invention

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requirements of MPEP § 1.475.

Firstly, per 37 CFR 1.475(a) independent claims 92 and 103 are directed to the "same or corresponding special technical features"—namely those features that relate to the provision of a head-up display image of a cable "that appears...to be a real object" (claim 92) or a virtual optical image that "moves along a three-dimensional path" that is "perceived...to be an extended object extending along the path" (claim 103)."

Moreover, per 37 CFR 1.475(b), claims 92 and 103 have unity of invention as being one or both of

- A product and process of use of said product, per 37 CFR 1.475(b)(2)
- A process and an apparatus or means specifically designed for carrying out the said process, per 37 CFR 1.475(b)(4)

Even if the Criteria of MPEP §806.05(d) Were Relevant,
Inventions I and II Do Still Define Only One Invention

The considerations cited in the Office action based on MPEP §806.05(d) regarding "subcombinations" and "separate utility" do not apply, as discussed above. But even if they did, the purported application of MPEP §806.05(d) to applicants' claims is erroneous for at least the following reasons:

1. Inventions I and II are method and apparatus claims, respectively. By definition, then, they cannot be "sub-combinations usable together in a single combination." Attention is directed to the example in the 5th paragraph of MPEP §806.05(d), where the following example is posited:

...if an application claims ABC/B/C wherein ABC is a combination claim and B and C are each subcombinations ...

This example makes clear that order for two things to be subcombinations of something else, it must be possible to have a claim that contains *both* subcombinations. That is a legal impossibility when one so-called "sub-combination" is a method and another so-called "subcombination" is an apparatus.

2. MPEP §806.05(d) cited in the Office action is not even applicable to the

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present application because MPEP §806.05(d) only applies to situations in which an applicant "separately claims plural subcombinations usable together in a single combination AND claims a combination that requires the particulars of at least one of said subcombinations." No such set of claims exists in the present application.

3. Given the manner in which the Office action grouped the claims, it would appear that the basis for the grouping is substantially for the reason that the claims of Invention I are method claims and the claims of Invention II are apparatus claims. This is not a proper basis on which to assert that there are two inventions. See MPEP §806.05(e)
4. The Office action has not advanced any reasons as to why Inventions I and II have "separate utility" other than to repeat the language of the claims verbatim. In so doing, the only thing the Office action establishes is that the claims express the invention using different words.
5. Virtually every recitation in claim 92 finds a counterpart in the other independent claims, albeit sometimes in a more narrow way and/or in different words. Thus rather than being directed to separate inventions, all the claims in the present application are directed (albeit in method and apparatus form) to the same invention at varying levels of breadth. See MPEP §806.03.

Reconsideration is requested.

Respectfully submitted,
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